



Patent
Attorney Docket No. GEMS8081.215

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Schirmer, Timo
Serial No. : 10/709,613
Filed : 5/18/2004
For : Method and System of Scaling MR
Spectroscopic Data Acquired with Phased-
Array Coils
Group Art No. : 2859
Examiner : Tiffany A. Fetzner

CERTIFICATION UNDER 37 CFR 1.8(a) and 1.10

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**COMMENTS ON STATEMENT
OF REASONS FOR ALLOWANCE**

Dear Sir:

Responsive to the Notice of Allowability mailed April 6, 2006, Applicant submits the following remarks responsive to the Examiner's Statement of Reasons for Allowance.

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U.S. Serial No. 10/709,613

REMARKS

In response to the Examiner's Reasons for Allowance, Applicant believes that a separate Statement of Reasons for Allowance is wholly unnecessary and inappropriate in the present case as the file history sufficiently sets forth the patentable distinctions of claims 1-20.

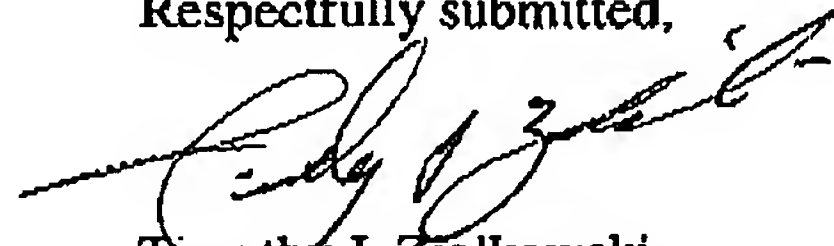
The Examiner purports to "reopen prosecution"; however, prosecution is deemed not reopened and it is believed that the Examiner's claim of reopening prosecution is wholly inappropriate. Applicant notes that the Notice of Panel Decision from Pre-Appeal Brief Review did not reopen prosecution, but specifically stated that the application was allowable and that "prosecution on the merits remains closed." Accordingly, the Examiner's actions in the Notice of Allowability are deemed moot and are merely noncontrolling *dicta*. It is clear based on the Panel's decision to allow the case, Applicant's arguments in its Pre-Appeal Brief Request for Review were persuasive and on point.

Further, the patentability of claims 1-20 lies in each claim as a whole. That is, a single particular element or feature of a claim does not define the claim's patentability, but rather, it is the combination of elements and the interconnection therebetween that define the invention. The claims cannot be considered to be limited in scope based on this brief statement by the Examiner. Applicant stands by its position previously set forth in the file history.

Applicant does not acquiesce to the Examiner's statements in the Reasons for Allowance nor the Examiner's paraphrasing of the claim elements. The bolding and underlining in the Examiner's "response to arguments" also have no bearing on claim interpretation since the Examiner has in effect been overruled by the Panel in the Panel's decision dated March 30, 2006.

Entry of these remarks is appreciated and Applicant cordially invites the Examiner to respond, should the Examiner disagree.

Respectfully submitted,



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